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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/595,803	05/12/2006	Mark Andrew Rowen	ROWE0101PUSA	6967

22045 7590 03/10/2008

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EXAMINER	
FRANK, NOAH S	

ART UNIT	PAPER NUMBER
1796	

MAIL DATE	DELIVERY MODE
03/10/2008	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	10/595,803	ROWEN, MARK ANDREW	
	Examiner	Art Unit	
	NOAH FRANK	1796	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *3* MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *12 May 2006*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-9* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-9* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☒ All b)☐ Some * c)☐ None of:

1.☒ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date *8/2/06*.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 6-8 rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claims 6-8 state, "The process of claim 4", however, claim 4 refers to a coating. For the purposes of examination claims 6-8 have been interpreted as –The process of claim 5--.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-3 are rejected under 35 U.S.C. 102(b) as being anticipated by Hovestadt et al. (US 5,453,460).

Considering Claims 1-2: Hovestadt et al. teaches a process for reusing the overspray obtained when spraying water dilutable two-component polyurethane coating compositions by collecting the overspray, reacting the overspray with compounds that are more reactive with isocyanate groups than both water and the compounds containing isocyanate reactive groups, and using the solution or dispersion in a coating

composition (Abs). The coating residue can be reconcentrated (extracted) by low pressure evaporation (2:35-45). The recovered overspray can be used in two-component polyurethane coating compositions, with addition of a polyisocyanate as hardener (7:35-40). The dispersion was applied as a two-component polyurethane coating composition (7:35-40).

Considering Claim 3: Hovestadt et al. teaches the isocyanate being based on hexamethylene diisocyanate (7:1-5).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claim 4 rejected under 35 U.S.C. 103(a) as being unpatentable over Hovestadt et al. (US 5,453,460) in view of Moriarty et al. (US 6,692,670).

Considering Claim 4: Hovestadt et al. teaches the basic claimed coating as set forth above.

Hovestadt does not teach the claimed MDI. However, Moriarty et al. teaches polymeric MDI comprising less than 48% diisocyanate (MDI) (3:30-35). Hovestadt and Moriarty are combinable because they are form the same field of endeavor, namely isocyanate binders. At the time of the invention a person of ordinary skill in the art would

have found it obvious to have used the polymeric MDI, as taught by Moriarty, in the invention of Hovestadt, as an equivalent alternative isocyanate.

Claims 5-7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hovestadt et al. (US 5,453,460) in view of Patzelt et al. (US 5,766,370).

Considering Claim 5: Hovestadt et al. teaches a process for reusing the overspray obtained when spraying water dilutable two-component polyurethane coating compositions by collecting the overspray, reacting the overspray with compounds that are more reactive with isocyanate groups than both water and the compounds containing isocyanate reactive groups, and using the solution or dispersion in a coating composition (Abs). The coating residue can be reconcentrated (extracted) by low pressure evaporation (2:35-45). The recovered overspray can be diluted (8:25-30) and used in two-component polyurethane coating compositions, with addition of a polyisocyanate as hardener (7:35-40). The dispersion was applied as a two-component polyurethane coating composition (7:35-40).

Hovestadt does not teach placing the paint waste stream in a still, separating the solvent, and then extracting the paint residue. However, Patzelt et al. teaches a paint overspray treatment by feeding a spent emulsion into a reaction vessel, the reaction vessel opearting under a vacuum and at a temperature sufficient to generate a volatilized organic solvent component (still), and removing residual material remaining in the reaction vessel after volatilizing the organic solvent (4:15-35). Hovestadt and Patzelt are combinable because they are form the same field of endeavor, namely paint

overspray recovery. At the time of the invention a person of ordinary skill in the art would have found it obvious to have extracted the paint residue, as taught by Patzelt, in the invention of Hovestadt, in order to efficiently remove excess solvent from the paint residue.

Considering Claims 6-7: Hovestadt et al. teaches reacting the isocyanate in an equivalent (stoichiometric) amount to hydroxyl groups (7:55-60).

Claims 8-9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hovestadt et al. (US 5,453,460) in view of Patzelt et al. (US 5,766,370), as applied to claims 5-7 above, further in view of applicant's admission of prior art.

Considering Claims 8-9: Hovestadt et al. teaches the basic claimed process as set forth above.

Hovestadt does not teach purifying the residue according to specific gravity before combining with hardening agents and pigments. However, applicant has admitted that it is well known in the art that upon standing, paints will settle out with the heavy pigments falling to the bottom and the clear resin solution sitting on top (4:15-20 of instant specification). At the time of the invention a person of ordinary skill in the art would have found it obvious to have removed pigments according to specific gravity, as taught by applicant, followed by addition of the curing agent and new pigments, in order to make a coating of a different color, thereby adapting the claimed method to multiple scenarios.

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Correspondence

Any inquiry concerning this communication or earlier communications from the examiner should be directed to NOAH FRANK whose telephone number is (571)270-3667. The examiner can normally be reached on M-F 9-5 EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mark Eashoo can be reached on 571-272-1197. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Mark Eashoo/ NF
Supervisory Patent Examiner, Art Unit 1796 2-21-08
2-Mar-08